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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/584,384	06/26/2006	Yasuji Kusuda	2006_1031A	9033
513 7590 07/23/2008 WENDEROTH, LIND & PONACK, L.L.P. 2033 K STREET N. W. SUITE 800 WASHINGTON, DC 20006-1021				
EXAMINER				
CONNELLY CUSHWA, MICHELLE R				
ART UNIT		PAPER NUMBER		
2874				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/584,384

Applicant(s)

KUSUDA ET AL.

ExaminerMICHELLE R. CONNELLY
CUSHWA**Art Unit**

2874

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. ____.
 - 3) ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 9/24/07, 6/26/06
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

DETAILED ACTION

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

The prior art documents submitted by applicant in the Information Disclosure Statements filed on September 24, 2007 and June 26, 2006 have all been considered and made of record (note the attached copies of form PTO-1449).

Drawings

Twelve (12) sheets of formal drawings were filed on June 26, 2006 and have been accepted by the Examiner.

Specification

Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kusuda et al. (JP 2002-202849) in view of Watanabe et al. (US 2001/0038493 A1), Sakurada et al. (US 7,087,308 B2), Tanimoto et al. (JP 07-306748) and Saito (JP 10-073805).

Regarding claims 1-3 and 5-7; Kusuda et al. discloses a touch panel protective panel for an electronic device (LCD; see the abstract and paragraphs 3 and 39) comprising:

- a transparent protection panel main body having a transparent window section (see Figures 1 and 2) formed therein;
- a display device (screen display; see abstract) located on a lower side of the protection panel and arranged so as to be visually recognizable from an outside through the transparent window section; wherein
- the protection panel comprises:
 - o a transparent protection panel main body (see Figures 1 and 2) on an upper surface of which is provided with a transparent lower electrode (22) and a lower circuit (bus lines 23a and 23b, and

- circuits, 24a and 24b) provided around the transparent electrode (22) so as to be located on the periphery of the protection panel;
- a movable electrode film (first conductivity panel, 1) in which a transparent upper electrode (12) is provided in a position opposite to the transparent lower electrode (22) in the protection panel main body and an upper circuit (bus lines 13a and 13b, and circuits 14a and 14b) provided around the transparent electrode (12) so as to be located on a periphery of the panel and arranged on an upper side of the protection panel main body via an air layer in which the peripheral portions therefor are bonded to the transparent protection main body.

Kusuda et al. does not disclose a casing in which the protection panel is fitted, a decoration layer, or a cover film of transparent resin.

Kusuda et al. does teach that the touch screen protective panel is for use with a screen display, which may be an LCD (see paragraphs 3 and 39 and the abstract). Saito and Tanimoto et al. each disclose LCDs with protective touch panels (see reference numbers 11 in Tanimoto et al. and 2 in Saito) placed within the recess of a casing (see reference numbers 13 in Tanimoto et al. and 4 in Saito) to cover, protect and provide a window for viewing an LCD (see reference numbers 7 in Tanimoto et al. and 1 in Saito). One of ordinary skill in the art would have found it obvious to place the touch screen disclosed by Kusuda et al. within a recess of a casing for an LCD device, as is known in the art, to provide protection and a touch screen input for the LCD

device, in a manner without a gap therebetween the outer surfaces of the protection panel and the casing, wherein the surface are flush with each other (see Figures 1 and 4 of Tanimoto et al. and Figures 1 and 2 of Saito) to prevent dust and moisture from affecting the LCD located below the protective touch screen panel. It is further noted that any panel or layer placed on top of an LCD will inherently provide some degree of protection.

Sakurada et al. teaches that a resin film (5) for preventing scattering and reflecting may be formed on a protective panel for a display. One of ordinary skill in the art would have found it obvious to further provide a cover film of transparent resin having the same dimension as the protection panel layers that is covering on the touch panel disclosed by Kusuda et al. to provide further protection for the touch screen and to prevent unwanted reflections and scattering as is known in the art.

Watanabe et al. teaches that a colored printed section (11) may be formed on the periphery of a protective panel (P) for an electronic device (see Figures 1a-1c). Sakurada et al. teaches that a colored portion (4) may be formed on the periphery of a protective panel (see Figure 2) for a display device. One of ordinary skill in the art would have found it obvious to provide a colored, printed, decorative portion on either the bottom or the top of a layer of the protective touch screen panel disclosed by Kusuda et al. to cover the circuits located on the periphery of the panel and hide them from the view of the user of the electronic device or display and provide an aesthetically appealing design on an outer surface of the panel.

Regarding claims 4, 8 and 11-14; applicant is claiming the product including the process of making the upper surface of the cover film, and claims 4, 8 and 11-14 are therefor of "product-by-process" nature. The courts have been holding for quite some time that: the determination of the patentability of product-by-process claim is based on the product itself rather than on the process by which the product is made. *In re Thrope*, 777 F. 2d 695, 227 USPQ 964 (Fed. Cir. 1985); and patentability of claim to a product does not rest merely on a difference in the method by which that product is made. Rather, it is the product itself which must be new and unobvious. Applicant has chosen to claim the invention in the product form. Thus, a prior art product which possesses the claimed product characteristics can anticipate or render obvious the claim subject matter regardless of the manner in which it is fabricated. A rejection based on 35 U.S.C. section 102 or alternatively on 35 U.S.C. section 103 of the status is eminently fair and acceptable. *In re Brown and Saffer*, 173 USPQ 685 and 688; *In re Pilkington*, 162 USPQ 147.

As such no weight is given to the process steps recited in claims 4, 8 and 11-14.

Regarding claims 9 and 10; the prior art discloses the limitations of claim 9 as applied above. A bonding plate member (3) is used to bond the films (11, 21) in such a manner that an air layer is formed on an upper side of the plate member (2). One of ordinary skill in the art would have found it obvious to form multiple protection panels in a batch process on and to further cut together the plate member, the transparent resin film and the cover film that are bonded to form the protection panels outside of the

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periphery of the transparent electrodes to obtain individual protection panels, as batch processes are commonly used to form multiple panels within the art.

Conclusion

Any inquiry concerning the merits of this communication should be directed to Examiner Michelle R. Connelly-Cushwa at telephone number (571) 272-2345. The examiner can normally be reached 9:00 AM to 7:00 PM, Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rodney B. Bovernick can be reached on (571) 272-2344. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general or clerical nature should be directed to the Technology Center 2800 receptionist at telephone number (571) 272-1562.

/Michelle R. Connelly-Cushwa/
Patent Examiner
July 18, 2008